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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,650	10/15/2001	Per Sjoberg	0459/00346	5908

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/869,650

Applicant(s)

SJOBERG, PER

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 11 and 14-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 11 and 14-21 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. The amendment filed on February 24, 2003 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected. In the reply, applicants amended the claims corresponding to the elected invention, Group I (claims 1-2 and all claims depending therefore), to be a different invention than originally elected. See paragraph 2 and the following paragraphs below on this issue.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

2. Group I as originally presented, was drawn to a method of making a device. Upon reconsideration, the portion of paragraph 2 of Paper No. 8 that states “[a]pplicant is entitled to a composition and a method of use” is incorrect and not in accordance with MPEP 1850:

PCT Rule 13.2, as it was modified effective July 1, 1992, no longer specifies the combinations of categories of invention which are considered to have unity of invention. Those categories, which now appear as a part of Annex B to the Administrative Instructions, has been substituted with a statement describing the method for determining whether the requirement of unity of invention is satisfied. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term “special technical features” is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings.

The above quoted statement as to “entitled to” from the prior action is withdrawn.

3. The amendment filed on February 24, 2003 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because they are now

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amended to a "process for releasing gas in ... safety devices...". This is clearly distinct from the original "Process for the preparation of gas-actuated car safety devices...". As to this, that there is no common "special technical feature" between Group I as originally presented, and Group I as now amended, is also demonstrated since the subject matter of original Group I has been cancelled by the amendment to the claims, subsequent to rejections including based on prior art. PCT Rule 13.2. That which is not patentable over the prior art, cannot be a "special technical feature".

4. In view of applicants reply, applicant is required to adhere to the invention originally elected. The prior generosity of examining Group II along with Group I is withdrawn for two reasons. First, Group I has been cancelled by amending it to a distinct invention. Second, Group II has been changed to be a distinct invention of a plurality of certain specific compounds in a composition. Originally Group II only recited guanidine dinitramide. Now, a distinct mixture is recited of guanidine dinitramide with additionally at least guanyl urea dinitramide. It is submitted that such a composition is distinct from the originally claimed Group II, as in the sense of PCT Rule 13.2, that there is no special technical feature in common. Indeed as set forth above, cancellation [or amendment to delete the original subject matter] of the original Group II claims stands for the proposition that there is no common (patentable) special technical feature in both Groups II, original and amended. In any event, the examiner is unwilling to extent a generosity that would be a burden by the amendment of the originally claimed subject matter.

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, all claims are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicant is required to restrict the claims to the originally elected invention.

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6. If applicants desire to prosecute a distinct invention lacking a special technical feature with the invention originally elected, the proper way to do this is to file a divisional application.

7. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
September 22, 2003



**EDWARD A. MILLER  
PRIMARY EXAMINER**